

REMARKS

The arguments and amendments, hereinabove, are in response to the Office Action dated December 28, 2006. Prior to the present communication, claims 1–18 were pending in the subject application. Claims 1, 3, 9, and 15-18 have been amended herein and no claims have been cancelled. Accordingly, all claims remain pending. It is respectfully submitted that no new matter has been added by way of the present amendments. Reconsideration of the subject application is respectfully requested in view of the above amendments and the following remarks. Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, while claims 1, 3, and 18 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1-8 and 15-17 stand rejected under 35 U.S.C. § 101. Claim 18 stands rejected under 35 U.S.C. § 102(e). Lastly, claims 1-17 stand rejected under 35 U.S.C. § 103.

Summary of Telephonic Interview

Applicant thanks the Examiner (Hung Q. Pham) for being available for, and participating in, a telephonic interview that occurred on March 6, 2007 in which Applicant's representatives discussed the differences between the claimed invention and the references cited in the Office Action. Specifically, Applicant's representatives brought to the attention of the Examiner that the inventive aspects of the present invention, including the aspects of "validating," are not taught by the U.S. Patent No. 6,721,414 to Rojas et al. (hereinafter the "Rojas reference"). The Examiner indicated that "validating" is novel as defined by the specification and suggested ways to amend the independent claims in a manner that will assist in clarifying the differences between the claimed invention and the Rojas reference.

Claim Objections

Claim 18 stands objected to for the informality of stating “cable-label records record” whereby the Examiner has suggested the following amendment: “cable-label records ~~record~~.” In response, the Applicant directs the Examiner to the specification at paragraph [0045] that discusses the cable-label running list and FIG. 3 that illustrates individual records that are associated with the cable-labels and are stored in a list, *i.e.*, record. As such, no amendment is necessary, and proper antecedent language to support claim 18 is presented in the specification. However, the preamble of claim 18 has been amended to match these specific limitations.

Rejections based on 35 U.S.C. § 112

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In response, the Applicant directs the Examiner to the specification at paragraph [0040] that states the “cable-label data can be *automatically* generated from the cable-running-list data” (emphasis added). Next, it is stated in the Specification at paragraph [0028] that the “[C]ontrol application 112 receives the query submitted by field engineer 110 and facilitates a search of the database 114 to retrieve matching records . . . control application 112 may output label file 118, which also contains cable-label data and can be inputted into a printer to print the cable labels from the label file 118.” In addition, the “label-file controller 134 produces a file that is compatible with a printer or printing software of choice.” *See, Specification* at page 8, ¶ [0032]. Accordingly, there is sufficient support in the specification to reasonably convey that, at the time of the invention, the Applicant had possession of “automatically, providing a data stream that when rendered by the printing device produces label records” without additional input from the field, upon generating the cable-label file. As such, it is believed that the objection to claim 1 has been overcome.

Claims 1, 3, and 18 are rejected under 35 U.S.C. § 112, second paragraph, as failing to comply with the written description requirements. Claim 1 has been amended per the Examiner's suggestion to recite "automatically[,] providing a data stream that when rendered by the printing device produces printed cable-label records, wherein the printed cable-label records displaying content of the identified records in a prescribed format." Claim 3 has been amended in order to avoid being unclear, and now recites "wherein the cable-label records include content that is to be ~~printed~~ displayed on the printed cable-label records." Claim 18 has been amended to recite "validating the set of data to remove errors associated with the information related to the cable," which receives its antecedent basis from the specification at page 6, paragraph [0006].

Rejections based on 35 U.S.C. § 101

Claims 1-8 stand rejected under 35 U.S.C. § 101, for being directed at non-statutory subject matter. In particular, the Examiner states that "tangible computer-readable media" includes signals, which is not one of the four recognized statutory categories. In response, the specification has been amended, as presented hereinabove, to remove mention of signals in relation to computer-readable media.

Claims 15-17 are rejected for being directed toward a system that comprises software per se, which is not one of the four recognized statutory categories. In response, Applicant has amended claim 15 to recite "A computer system for printing cable-label records, the computer system comprising:" whereby the "computer system" is recognized as a machine, and is within the statutory categories. As such, the amended claim 15, and claims 16 and 17 depending thereon, are considered statutory, and thus, the rejection is traversed.

Rejections based on 35 U.S.C. § 102(e)

A.) Applicable Authority

Anticipation “requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee.” MPEP § 2131, *passim*; *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995). “[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference.” *Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research*, 304 F.2d 1221, 1227 (Fed. Cir. 2002) (citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988)). “The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention.” *Id.* (emphasis added)(citing *Crown Operations Int’l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002); *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)). *See also*, *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996).

B.) Anticipation Rejection Based on U.S. Patent No. 6,721,414 to Rojas et al.

Claim 18 has been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,721,414 to Rojas et al. (hereinafter the “Rojas reference”). As the Rojas reference does not describe, either expressly or inherently, each and every element of claim 18, the Applicant respectfully traverses the rejection of this claim, as hereinafter set forth.

Independent claim 18, as amended hereinabove, recites a method for printing cable-label records and “validating” to remove processing errors. The method of claim 18 comprises “*validating* the set of data to remove errors associated with the information related to the cable, wherein *feedback is offered* upon recognizing the errors” (emphasis added).

The Rojas reference, on the other hand, does not disclose the step of validating as recited by claim 18. In direct contrast, the Rojas reference will not let a user enter a new component with an error into the cable manager database. “Each time a new component is entered into the cable manager database, its type must be selected from a predefined list.” *See, Rojas Reference* at col. 7, ll. 58-61. The user interface is illustrated at FIG. 5 and shows a set of options from a predefined list for a user to select, wherein the cable record is input based on a these options so that no errors can be entered into the system. That is, the errors are “removed” prior to entering into the database by the user, not upon an internal step of “processing errors” within the server. Moreover, because the errors may not be entered at the user interface, no errors can exist within the cable manager database. As such, the cable manager database is unable to offer feedback upon recognition of errors.

As such, it is respectfully submitted that the Rojas reference fails to describe, either expressly or inherently, a method of (a) validating the set of data to remove error associated with the cable, wherein (b) feedback is offered upon recognizing the errors. Rather, the Rojas reference describes a method for entering data based on a pre-identified options so that no errors may be input, and as such, no feedback regarding errors is offered. For at least the reasons stated above, it is respectfully requested that the 35 U.S.C. § 102(e) rejection of independent claim 18 be withdrawn.

Rejections based on 35 U.S.C. § 103(a)

A.) Applicable Authority

The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure. MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). To establish a *prima*

facie case of obviousness, all the claim limitations must be taught by the prior art. MPEP § 2143.03; *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03; *In re Wilson*, 57 C.C.P.A. 1029, 1032 (1970). Further, "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP § 2143.03.

B.) Obviousness Rejection Based upon the Brady Worldwide "LabelMark Labeling Software in view of the Rojas Reference.

Independent claims 1, 9, and 15 stand rejected under 35 U.S.C. § 103(a) for being obvious under Brady Worldwide "LabelMark Labeling Software" (hereinafter the "Brady reference") in view of the Rojas reference. Because the Rojas reference and the Brady reference, whether taken alone or in combination, fail to teach or suggest all of the limitations of independent claims 1, 9, or 15, the Applicant respectfully traverses these rejections, as hereinafter set forth.

Independent claims 1, 9, and 15, as amended hereinabove, all recite the limitation of "validating to remove processing errors, wherein feedback is offered upon recognizing the processing errors" or a variation thereof. As stated in the Office Action, "Brady does not explicitly teach the data of the label records is *cable* data and the claimed limitation *validating one or more records to remove processing errors when the one or more records are stored.*" Additionally, as previously discussed with reference to § 102(e), the secondary reference, Rojas, does not teach the limitation of "validating" as recited in claims 1, 9, and 15. As such, Rojas fails to cure the deficiencies of Brady.

In view of the above, it is respectfully submitted that the proposed combination of the Rojas reference and the Brady reference, whether taken alone or in combination, fail to teach or suggest all of the limitations of claims 1, 9, and 15, and as a matter of law the Examiner's rejection cannot stand. Dependant claims 2-8, 10-14, 16, and 17 depend from independent claims 1, 9, and 15 respectively, and are allowable based in part on their dependency thereon. As such, it is respectfully requested that the 35 U.S.C. § 103(e) rejection of these claims be withdrawn. Each of claims 1-17 are believed to be in condition for allowance and such favorable action is respectfully requested.

CONCLUSION

For the reasons stated above, claims 1-18 are now in condition for allowance. The applicant respectfully request withdrawal of the pending rejections and allowance of claims 1-18. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required (or to credit any overpayment) to Deposit Account No. 21-0765.

Respectfully submitted,

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